

REMARKS

Favorable reconsideration and allowance of this application are requested.

1. Discussion of Amendments

By way of the amendment instructions above, several of the informalities noted helpfully by the Examiner have been addressed. Thus, the non-statutory "use" defined by claim 19 has been recast as a claim directed toward an intermediate for pharmaceutical products which comprises a product of the process of claim 1.

The subject matter of claims 3 and 4 (directed to the solvents and ozonolysis temperatures, respectively) has been incorporated into claim 1. Claims 3 and 4 have therefore been canceled as redundant.

Therefore, following entry of this amendment, claims 1-2 and 5-19 will remain pending in this application for which favorable action is solicited.

2. Response to 35 USC §101 Issue

The amendment to pending claim 19 is believed to render moot the assertion of non-statutory subject matter being defined thereby. Accordingly withdrawal of the rejection advanced under 35 USC §101 is in order.

3. Response to 35 USC §112 Issues

The amendments made to pending claim 19 are also believed to render moot the rejection advanced against such claim under 35 USC §112, second paragraph.

Reconsideration and withdrawal of the rejection advanced against claims 1-19 based on the applicants' use of the nomenclature "allylamine" is requested. In this regard, a "homoallylamine" (which apparently the Examiner prefers) is in fact an

"allylamine" (which is employed in the pending claims). In other words, according to applicants' understanding of such terminology, the latter term is a generic description of the former term. Thus, applicants can see no issue under 35 USC §112, second paragraph being raised by such terminology since the compound of formula (I) is in fact an "allylamine" and since all substituents in formula (I) are specifically and unequivocally defined. As such, claim 1 is entirely definite within the statutory purview of 35 USC §112. Moreover, since applicants can be their own lexicographer and since the terminology employed in the claims is not inconsistent with the general nomenclature for allylamines, there really can be no objection to the language employed by the applicants in pending claim 1 as asserted by the Examiner. Withdrawal of the rejection advanced under 35 USC §112, second paragraph is therefore in order.

4. Response to 35 USC §103(a) Issue

The only substantive issue to be resolved in this case is the Examiner's assertion that pending claims 1-4, 7-10 and 12-18 are "obvious" and hence unpatentable under 35 USC §103(a) based on the combination of Boesten et al (US 2003/0097005) and Bailey (Chemical Reviews, The Reactions of Ozone with Organic Compounds, 1958, 58(5), pgs. 925-1010).¹

Applicants note in this regard that the Examiner concludes that, due to Bailey's disclosure of the use of various solvents (page 986, first three paragraphs) at various temperatures between -25°C to +25°C and the oxidation of a large variety of substances to the carboxylic acid in the presence an oxidizing agent (page 989, Table 7) and the catalytic reduction to produce aldehydes (page 991, Table 8, entries 1 and 4), one of ordinary skill in this art would "obviously" modify the process of Boesten so as to extend its utility to other product classes and optimize yields. The Examiner's rationale seems however to be flawed.

Specifically, as acknowledged by the Examiner, the entire thrust of Boesten is that oxidation after ozonolysis of **amide** allylamines to form the ester at temperatures of -78°C may be practiced, e.g., as disclosed in Example XIV. However, as applicants read Example XIV, the “homoallylamine” that is subjected to ozonolysis is (R)-phenylglycine **amide**-(R)-isopropylhomoallylamine. Hence, as noted previously, Boesten is concerned with ozonolysis of **amide** allylamines.

Turning attention to formula (I) as defined in the presently pending claims, it can be seen that the substituent R5 cannot be an amino group ($-\text{NH}_2$). Thus, applicants respectfully cannot see where formula (I) would embrace the *amide* allylamines as disclosed by Boesten. Consequently, one of ordinary skill in this art, even if cognizant of the vast number of alternatives disclosed by Bailey, would not possibly arrive at the presently claimed invention as defined by the pending claims herein. Simply stated, even assuming that an ordinarily skilled person would combine Bailey with Boesten, the present invention would not result as the ozonolysis would be required (i.e., according to Boesten) to be practiced on an *amide* allylamine and not an allylamine as defined in formula (I) of the applicants’ pending claims. Given the unpredictability of which an ordinarily skilled person would be cognizant, he would not “obviously” substitute the nonamide-allylamines as defined herein in the Boesten process and arrive at the presently claimed invention.

Withdrawal of the rejection advanced against the pending claims under 35 USC §103(a) is therefore in order.

5. Conclusion

Every effort has been made to advance prosecution of this application to allowance. Therefore, in view of the amendments and remarks above, applicants

¹ The inclusion of the subject matter of claims 3 and 4 in pending claim 1 renders moot the Examiner’s anticipation rejection advanced under 35 USC §102(b) based on Boesten et al alone.

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suggest that all claims are in condition for allowance and Official Notice of the same is solicited.

Should any small matters remain outstanding, the Examiner is encouraged to telephone the Applicants' undersigned attorney so that the same may be resolved without the need for an additional written action and reply.

An early and favorable reply on the merits is awaited.

6. Fee Authorization

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140.

Respectfully submitted,

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